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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,711	07/25/2001	Takashi Shigetomi	8694.49USC1	8038
23552	7590	04/02/2004	EXAMINER	
MERCHANT & GOULD PC			PEYTON, TAMMARA R	
P.O. BOX 2903			ART UNIT	
MINNEAPOLIS, MN 55402-0903			PAPER NUMBER	
			2182	

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,711

Applicant(s)

SHIGETOMI ET AL.

Examiner

Tammara R Peyton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. 09/052,408.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 28-32, 34, 35, 36-38, and 40, are rejected under 35 U.S.C. 103(a) as being unpatentable over *Feamster et al.*, patent no. 5,235,586 and *Matsumoto*, European patent number 0193635.

As per claims 28, 29, 34, 35, 37, and 40, *Feamster* teaches a disk storage media (removable optical disk cartridge, 10, Fig. 1, 101, Fig.2), comprising an information storage portion (col. 5, lines 29, 32) for storing information and an electronic circuit portion (115, Fig. 2, col. 5, lines 24-29) for processing the information and wherein the information storage portion storing a plurality of information to be used in an external system (102, Fig. 2, col. 5, lines 36-47) having a

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system control portion. However, *Feamster* does not teach of said electronic circuit portion including discrimination and selecting means.

Matsumoto teaches an information storage portion (RAM, 22 and ROM, 21) and a electronic circuit portion (CPU, 20, Fig. 2), wherein the information storage portion stores a plurality of information (Fig. 3) to be used in an external system (Fig. 4) having a system control portion.

Matsumoto's electronic circuit portion includes discriminating means for discriminating an operation condition of the external system that depends upon a specific external system *Matsumoto's* IC card is inserted. *Matsumoto* teaches the selecting means for selecting information matched with the operation condition of the external system among those stored in from the plurality of information stored in said information storage portion, and notifying means for notifying an identifier showing a storage portion of the selected information (step n47 and n48, Fig. 6) stored in the information storage portion so as to allow the use of the external system. (*Matsumoto*, Abstract, pgs. 3-7, Figs. 1-7)

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Matsumoto's storage medium design differs from that of Applicant's however it would have been obvious to one of ordinary skill that *Matsumoto's* system logic that incorporates a discriminating and selecting means recognizes an operation condition of an external system and allows the external system to read out the selected information could be implement in an optical disk design of *Feamster* without departing from its inventive concept. The motivation would have been to expand *Matsumoto's* IC card system by enhancing its flexibility in the every changing market.

As per claim 30, *Feamster* teaches wherein the external system comprises a computer system and information stored in the information storage system could be a system control program.
(*Feamster*, col. 4, lines 10-11)

As per claims 31, 32, and 38, *Matsumoto* teaches wherein the external system is a terminal computer and depending upon which terminal the IC card is inserted, an emulator of a system program is matched accordingly.

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Claims 33, 36, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Feamster et al.*, patent no. 5,235,586 and *Matsumoto*, European patent number 0193635 as applied to claims 28-32, 34, 35, 36-38, and 40 above, and further in view of *Schmidt et al.*, patent number 5,423,054.

As per claims 33, 36, and 39 *Feamster* nor *Matsumoto* teach wherein the external system is a computer system having a printer and the information stored in the information storage portion is a parameter for adjusting a printer condition. However, *Feamster-Matsumoto* teach selecting information matched for an operation condition of the external system; therefore; one of ordinary skill would readily recognize that the plurality of information stored on the information storage portion could include information for other operating conditions.

Nonetheless, *Schmidt* discloses a disk storage media (disk, 10, Fig. 1) and an external system (PC, 62, Fig. 12) having a printer (66, Fig. 12). The printer is for printing indicia indicative of a monetary value, i.e. postage stamp. The disk storage media includes an information storage portion (38, Fig. 2a) wherein the information storage portion is for storing data expressive of a monetary value associated with printed indicia.

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It would have been obvious to one of ordinary skill at the time the invention was made that the information stored in said information storage portion of the disk storage media would include monetary value parameters for adjusting the printer condition. (*Schmidt*, col. 11, lines 60- col. 12, lines 68, col. 13, lines 7-10)

It would have been obvious to one of ordinary skill at the time the invention was made to implement the limitations of *Schmidt* with *Feamster-Matsumoto* because would add and expand the flexibility to the *Feamster-Matsumoto* system.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action

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is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (703) 306-5508. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mailed responses to this action should be sent to:

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Commissioner of Patents and Trademarks

Washington, D.C. 20231.

Faxes for Official/formal (After Final) communications or
for informal or draft communications (please label "PROPOSED" or
"DRAFT") sent to:

(703) 872-9306

Hand-delivered responses should be brought to:

USTPO, 2011 South Clark Place, Customer Window
Crystal Plaza Two, Lobby Room 1B03, Arlington, VA,

22202Crystal Park II, 2121.



JEFFREY GIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Tammara Peyton

March 22, 2004